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Paper No. 5

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OFFICE OF PETITIONS

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San Jose, CA 95113

In re Application of  
Hubbard, et al.  
Application No. 09/520,686  
Filed: March 7, 2000  
Attorney Docket No. VLSI-3234  
For: WAFER TARGET DESIGN AND  
METHOD FOR DETERMINING CENTROID  
OF WAFER TARGET

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: DECISION REFUSING STATUS  
: UNDER 37 CFR 1.47(a)  
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OFFICE OF PETIT

This is in response to the petition under 37 CFR 1.47(b), filed July 18, 2000. This petition is being treated under 37 CFR 1.47(a) due to the fact that petitioner has submitted a declaration properly executed by at least one of the named inventors.

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed March 7, 2000 without an executed oath or declaration and naming Bryan Hubbard and Pierre Leroux as joint inventors. Accordingly, on May 9, 2000, a Notice to File Missing Parts of Nonprovisional Application ("Notice") was mailed, requiring an executed oath or declaration, a surcharge for its late filing, and the statutory basic filing fee. The instant petition was filed in response.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 USC §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

Petitioner lacks item (1) set forth above. Petitioner has failed to establish that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings). The declaration of Mr. Wagner states that on several occasions the application papers were sent to the non-signing inventor at the non-signing inventor's work address and that petitioner either received no

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response or the package containing the application papers was returned as undeliverable.

Customarily, a last known address refers to a last known residential address rather than a business address. Petitioner has provided no explanation as to why a copy of the application papers was not forwarded to the inventor at the inventor's last known residential address.

To the extent that the application papers were forwarded to the inventor's last known business address, petitioner has failed to provide evidence that the inventor actually received the application papers and thereafter refused to execute the oath or declaration. Specifically, the instant petition lacks copies of the cover letters accompanying the application papers (specification, claims, and drawings) and mailing receipts to establish that the inventor in fact received the package containing the application papers.

Petitioner is reminded that "before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney." See, MPEP 409.03(d).

Any renewed petition must be accompanied by sufficient evidence to establish that the inventor received the application papers (specification, claims, and drawings) and thereafter failed to respond to requests to execute the oath or declaration.

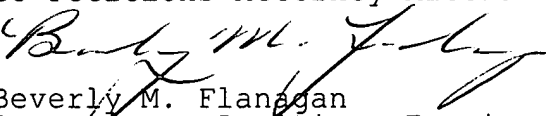
Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries regarding this decision should be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.

  
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